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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,353	07/27/2001	Francis Pruche	010830-119	6986

7590 05/08/2002  
Norman H. Stepno, Esquire  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, VA 22313-1404

EXAMINER
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BAHAR, MOJDEH

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/915,353

Applicant(s)

PRUCHE ET AL.

Examiner

Mojdeh Bahar

Art Unit

1617

-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-44 is/are pending in the application.
- 4a) Of the above claim(s) 20,26 and 35-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19,21-25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 19, 21-25 and 37-34, drawn to methods of treating an adverse condition of the skin, mucosa, nails or keratinous fibers of a subject comprising applying thereon an effective amount of at least one glucosylated hydroxystilbene compound or composition, classified in class 424, subclass 401 for example.
- II. Claim 20, drawn to a method for controlling skin pigmentation comprising applying thereon an effective amount of at least one glucosylated hydroxystilbene compound or composition, classified in class 424, subclass 401 for example.
- III. Claim 26, drawn to a method of promoting in vivo anti-oxidant and/or anti-inflammatory effect comprising applying onto the skin of the individual an effective amount of at least one glucosylated hydroxystilbene compound or composition, classified in class 424, subclass 401 for example.
- IV. Claim 44, drawn to a method for liberating a hydroxystilbene in stratum corneum comprising administering thereto an effective amount of at least one glucosylated hydroxystilbene compound, classified in class 424, subclass 401 for example.
- V. Claims 35-43, drawn to a topical composition comprising effective amount of at least one glucosylated hydroxystilbene compound, classified in class 424, subclass 401 for example.

Inventions V and I-IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

Application/Control Number: 09/915,353

Art Unit: 1617

product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case inflammation can be treated employing hydrocortisone cream, adverse skin conditions can be treated with vitamin A derivatives.

Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions In the instant case these inventions have different functions.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Stepno on 04/09/02 a provisional election was made without traverse to prosecute the invention of Group I, claims 19, 21-25 and 27-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20, 26, 35-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 19, 21-25 and 27-34 are herein examined on the merits.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19, 21-25 and 27-34 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by a well established utility.

These claims are drawn to regime/regimen. Employing "method" in lieu of regime/regimen would be favorably considered.

Claims 19, 21-25 and 27-34 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claims 19 and 27-34 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "combating signs of cutaneous aging and of hair follicle, to improve the radiance of the skin, to smooth the skin of the face, to treat or prevent wrinkles and fine lines in the skin or to stimulate the epidermal renewal process" is does not reasonably provide enablement for methods of treating any and all adverse condition of the skin, mucosa, nails or keratinous fibers. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Claims 19 and 27-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Treating all adverse condition of the skin, mucosa, nails or keratinous fibers is not taught in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19, 21-25, 27-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "desired" and "such period of time as required" in claims 19 and 21-25, "improving" in claim 22, "smoothing" in claim 23 and "preventing" in claim 24 are all relative terms which render the claims indefinite. The term "desired", "such period of time as required", "improving", "smoothing" and "preventing" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What is the desired response? For how long is the administration of the composition required? To what degree is the skin improved and/or smoothed? To what degree is the formation of wrinkles prevented?

The term "admixture thereof" in claim 32 renders the claim indefinite. Since only one compound is recited in the claim, it is not clear with what the compound is mixed.

The terms "vitis vinifera" and "polygonum caspidatum" renders claim 33 vague and indefinite because the precise chemical make-up of these extracts is not clear. Further the Skilled Artisan cannot ascertain which part of the plant or from which plant (e.g., which type of grape) the extract is taken.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 19, 21-25 and 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al. (WO 99/04747) and Waterhouse et al.

Carson et al. (WO 99/04747) teaches that resveratrol, a phytoestrogen present in red grapes, is useful in methods of inhibiting the proliferation of keratinocytes and stimulating their

Application/Control Number: 09/915,353

Art Unit: 1617

differentiation, improving the appearance of wrinkled, lined, dry, flaky, aged or photodamaged skin, improving skin thickness, elasticity, flexibility, radiance, glow and plumpness, see in particular abstract and claims 3-4. Carson et al. (WO 99/04747) also teaches that cosmetic compositions containing grape extract are known in the art, see in particular page 4 lines 23-33.

Waterhouse et al. teaches that both resveratrol and piceid (3,4,5-trihydroxystilbene-3-beta-mono-D-glucoside) are present in grape extract (i.e., *Vitis* species) as well as in *Polygonum cuspidatum* root, see in particular page 571.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ grape extract in Carson et al.'s methods of treating and/or improving skin conditions.

One of ordinary skill in the art would have been motivated to employ grape extract in Carson et al.'s methods of treating and improving skin because grape extract is known to contain both resveratrol and piceid (3,4,5-trihydroxystilbene-3-beta-mono-D-glucoside), known to be useful in cosmetic compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mojdeh Bahar whose telephone number is (703) 305-1007. The examiner can normally be reached on (703) 305-1007 on Monday, Tuesday, Thursday and Friday from 8:30 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.



Application/Control Number: 09/915,353

Page 8

Art Unit: 1617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Mojdeh Bahar  
Patent Examiner  
May 3, 2002

RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200